

REMARKS

I. Introduction

Claims 1 to 8 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of receipt of the certified copies of the priority documents.

II. Rejection of Claims 1 to 8 Under 35 U.S.C. § 103(a)

Claims 1 to 8 were rejected as unpatentable over U.S. Patent No. 6,567,335 ("Norman et al."). Applicants respectfully submit that Norman et al. do not render obvious the present claims for the following reasons.

Claim 1 relates to a memory arrangement and recites, inter alia, that the memory arrangement includes a first buffer memory and a second buffer memory. Claim 1 recites that in the case of a command access, at least one command following an access command is written to the first buffer memory, and that in the case of a data access, at least one datum following accessed datum is written to the second buffer memory. Claim 1 has been amended herein without prejudice to recite that the at least one command following the accessed command and the at least one datum following the accessed datum are written independently of one another. Support for the amendment claim 1 may be found, for example, on page 2, lines 5 to 22 of the Specification.

The Final Office Action makes reference to claims 29 and 32 of Norman et al. However, claims 29 and 32 of Norman et al., as well as the remaining description by Norman et al., fails to disclose or even suggest, that: (1) in the case of a command access, at least one command following an access command is written to a first buffer memory; and (2) in the case of a data access, at least one datum following accessed datum is written to a second buffer memory. That Norman et al. mention a command input buffer and a data input buffer in claim 29 and mention a command input buffer and a data input buffer in claim 32 do not constitute a disclosure, or even a suggestion of, (1) in the case of a command access, at least one command following an access command is written to a first buffer memory; and (2) in the case of a data access, at least one datum following accessed datum is written to a second buffer memory. Furthermore, Norman et al. make no disclosure

or suggestion of at least one command following an accessed command and at least one datum following an accessed datum being written independently of one another.

Claim 5 relates to a method for performing at least one of command access and data access during a program execution in connection with a programmable memory. Claim 5 recites that the method includes the steps of: recognizing in the case of a command access that a command access is present; recognizing in the case of a data access that a data access is present; writing a command following the accessed command to a first buffer memory; and writing a datum following the accessed datum to a second buffer memory. Claim 5 has been amended herein without prejudice to recite that the command and the datum are written in the writing steps independently of one another. Support for the amendment to claim 5 may be found, for example, on page 2, lines 5 to 22 of the Specification.

As more fully set forth above with respect to claim 1, it is respectfully submitted that Norman et al. do not disclose, or even suggest, that a command and a datum are written in writing steps independently of one another.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, supra. This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, it is respectfully submitted that Norman et al. do not disclose, or even suggest, all of the limitations of amended claims 1 and 5. It is therefore respectfully submitted that Norman et al. do not render obvious claims 1 and 5.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions do not properly support a § 103

rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects, at best, a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

- In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Final Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not the case here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

With respect to claims 1 and 5, the Final Office Action alleges that certain recited features are well known. Applicants respectfully traverse these contentions to the extent that they are maintained and request that the Examiner provide specific evidence to establish those assertions and/or contentions under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because this rejection is apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03).

Moreover, judicial or official notice that is based on subjective and unsupported reasoning will not sustain an obviousness rejection. In the M.P.E.P. cited case of In re Ahlert, 165 U.S.P.Q. 418, 420 to 421 (C.C.P.A. 1970), the Court made plain that:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant

given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. **Allegations concerning specific "knowledge" of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.**

In re Ahlert, 165 U.S.P.Q. at 420 to 421 (citations omitted).

Otherwise, if the Examiner cannot provide either references or an affidavit to support these contentions, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103 be withdrawn for this reason alone.

In addition, claims 2 to 4 depend from claim 1 and therefore include all of the limitations of claim 1. As set forth above, Norman et al. do not disclose, or even suggest, all the limitations of claim 1. It is therefore respectfully submitted that claims 2 to 4 are patentable over Norman et al. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

In addition, claims 6 to 8 depend from claim 5 and therefore include all of the limitations of claim 5. As set forth above, Norman et al. do not disclose, or even suggest, all the limitations of claim 5. It is therefore respectfully submitted that claims 6 to 8 are patentable over Norman et al. Id.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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